

REMARKS

Claims 1-12 and 14-23 are currently pending in the present application.

Claim 1 has been amended, without prejudice to the filing of one or more continuing applications directed to the previously presented subject matter thereof, to more specifically refer to and particularly point out various embodiments of Applicants' claimed invention wherein the process of reacting a fresh silica sol with guanidine carbonate is directed to the preparation of silica sols having the properties set forth in allowable claim 14 which is directed to such sols *per se*. Support for the amendments to claim 1 can be found throughout the Specification and in the original claims. No new matter is introduced by the amendments made herein. No additional claims fees are necessitated by the amendment made herein. Furthermore, a complete listing of all claims ever presented is set forth herein in accordance with 37 CFR §1.121(c)(1). Accordingly, entry of the amendment made herein and consideration thereof are proper and respectfully requested.

Rejections Under 35 U.S.C. §112, 2nd Paragraph:

In the June 6th Office Action, the Examiner rejects claims 1-12 and 22 under 35 U.S.C. §112, second paragraph, as being indefinite. Specifically, the Examiner contends that the terms "silica sol" and "fresh sol" are not clear. Additionally, the Examiner contends that claim 4 is indefinite because the claim recites "a reaction temperature," and it is not clear to the Examiner what temperature is being claimed. Applicants respectfully traverse the Examiner's rejections under 35 U.S.C. §112, second paragraph, for at least the following reasons.

With respect to the use of terms "fresh sol" and "silica sol," Applicants respectfully submit that both terms are well understood by those of ordinary skill in the art, and are additionally described and defined in the Specification, such that one of ordinary skill in the art would readily recognize and understand the meaning of the terms as used in the claims, particularly when read in light of the Specification. More specifically, the known term silica sol is clearly defined in the Specification, for example, at page 1, lines 7-10, as "sedimentation-stable, colloidal solutions of amorphous SiO₂ in water or alcohols and other polar solvents."

“Silica sol” is a well understood term of art and requires no clarification for those of ordinary skill in the art. Moreover, the term “fresh sol” is clearly defined in the Specification, for example, at page 3, lines 4-6, as “an alkali-free SiO₂ solution produced, for example, by removing alkaline metal cations from water glass.” Applicants respectfully submit that not only are the terms well-recognized in the art and understood by those of ordinary skill in the art, but furthermore, the terms are clearly described in the Specification such that one of ordinary skill in the art would readily understand the terms as used. Accordingly, Applicants submit that there is no lack of clarity in the use of the terms “fresh sol” and “silica sol.”

With respect to claim 4, Applicants respectfully submit that the Examiner’s rejection is improper. Claim 4 of the instant application reads as follows:

“The process of claim 2, wherein the reaction is carried out at a reaction temperature at a pH of from 8 to 12, the pH being measured at the reaction temperature.”

Applicants respectfully submit that the recitation of “a” reaction temperature in claim 4 is not indefinite, and merely provides *proper antecedent basis* for the recitation of “the” reaction temperature in the subsequent clause of the claim. Applicants clearly describe suitable reaction conditions for the various embodiments of the instant invention, for example, at page 5, lines 25-29 of the Specification, wherein the pH, measurement thereof and suitable exemplary reaction temperatures are described. More specifically, the Specification states that the reaction is carried out, for example, at a temperature of from 25°C to 100°C. *Applicants respectfully submit that no particular temperature is being claimed in claim 4.* The recitation of a reaction temperature simply provides proper antecedent basis for the temperature *at which the pH is then measured*. In other words, the temperature can be any suitable temperature at which the reaction can be carried out. The reference to the reaction temperature is merely that temperature at which the pH is measured, and that pH must be 8 to 12, as set forth in the claim. Applicants respectfully submit that there is no lack of clarity in the use or recitation of “a” reaction temperature. In fact, the claim would be less clear if the phrase were not used to provide the

proper antecedent basis for the remainder of the claim. Reconsideration and withdrawal of the rejection in this regard are respectfully requested.

Applicants respectfully submit that all pending claims fully comply with the requirements of 35 U.S.C. §112, second paragraph. Accordingly, reconsideration and withdrawal of the rejection are requested.

Rejection Under 35 U.S.C. §103(a):

In the June 6th and June 2nd Office Action, the Examiner rejects claims 1-12 and 22 under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent No. 3,630,954 of Yates, in view of U.S. Patent No. 5,603,805 of Andersson, *et al.* While not agreeing with the Examiner's rejection or any of the arguments and contentions set forth in support thereof, which arguments and contentions are repetitive of prior rejections previously overcome by Applicants, *in an effort to expedite prosecution of the allowable subject matter, as indicated in the June 2nd and June 6th Office Actions*, Applicants have amended independent process claim 1 to incorporate the specific characteristics of the prepared silica sol which are indicated as being patentable in the June 6th Office Action at pages 5-6. More specifically, *claim 1 has been amended to recite the preparation of a silica sol having the claimed BET surface area, percent content of guanidinium ions and being free of amine.*

Applicants respectfully submit that the amendment to claim 1 renders process claims 1-12 and 21 allowable for at least the same reasons pending claims 14-21 and 23 are allowed. Reconsideration and withdrawal of the rejection as to claims 1-12 and 21 are respectfully requested.

Conclusion:

Applicants respectfully submit that all pending claims patentably distinguish over the prior art of record for at least the reasons set forth by the Examiner in the June 6th Office Action, and that all claims comply with the requirements of 35 U.S.C. §112, second paragraph. Thus, withdrawal of all rejections and a Notice of Allowance are respectfully requested.

Respectfully submitted,

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